

## **REMARKS**

### **I. Introduction**

With the addition of claims 30 to 33, claims 1 to 33 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants respectfully request that the Examiner return an initialed copy of the IDS Form-1449 submitted on February 12, 2002 with the next Office communication indicating consideration of the listed references.

Applicants note with appreciation the acknowledgment of the claim for foreign priority. Clarification is requested, however, regarding an inconsistency between the Office Action Summary of August 20, 2003, which indicated that all copies of the certified copies of the priority documents have been received, and the present Office Action Summary, which indicates that none of the certified copies of the priority documents have been received. Applicants submitted a certified copy of the priority document on February 12, 2002, as evidenced by the attached copy of the U.S.P.T.O stamped postcard.

### **II. Rejection of Claims 11 to 29 Under 35 U.S.C. § 112, Second Paragraph**

Claims 11 to 29 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. See Office Action at par. 5.

The Office Action alleges that claims 11 to 29 are indefinite because they lack a claimed process step to produce a "tufted backing." Claims 11 to 29 have been amended to remove reference to the tufted backing.

The Office Action further alleges that it is unclear how the two fiber types are structurally related in the tufted backing. The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the "focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision." In this regard, the "essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and

particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, *inter alia*, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)). Applicants respectfully submit that claim 1, as amended, reasonably clearly conveys to one skilled in the art that portions of a spunbonded nonwoven having fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and that portions of the spunbonded nonwoven having a titer of 1 to 5 dtex are bonded by either water jets alone or using a combination of waters jets and needling.

The Office Action questions whether the spunbonded nonwoven is comprised of the blend of two fibers. The Office Action further queries how is it that the smaller fibers maybe be both hyrdoentangled and needlepunched, while the larger titer fibers are only needlepunched. Claim 11 claims a method for making a spunbonded nonwoven. The claim does not limit the resulting product, i.e., the spunbonded nonwoven, to one having only smaller or larger fibers. Rather, one skilled in the art would recognize that the spunbonded nonwoven may comprise a blend of the larger and smaller fibers so long as the limitations of the claim are met, namely, fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and that fibers or filaments with a titer of 1 to 5 dtex are bonded by either water jets alone or using a combination of waters jets and needling. It follows that a portion of a spunbonded nonwoven having both larger and smaller fibers necessarily must be bonded by needling alone given the existence of the larger fibers in this portion.

Regarding claim 14 and 15, the Office Action alleges that it is unclear what “treatment” occurs due to the pair of heated rollers. The claims recite that after thermosetting an additional treatment is performed with a pair of heated rollers. Applicants respectfully submit that claims 14 and 15 are not and need not be limited to a specific treatment. Applicants note, however that in one example embodiment, the Specification states that the thermoset sheet is calendered with an embossing

roller, wherein the calendering surface temperature is 220 degrees Celsius. See Specification p. 5, lines 25 to 28.

Regarding claims 16 and 17, the Office Action alleges that it is unclear how the surface roughness is measured in units of length. Applicants respectfully submit that one skilled in the art would recognize that surface roughness may be measured in units of length. See, e.g., Marks' Standard Handbook for Mechanical Engineers (9<sup>th</sup> ed. 1987), at 13 to 79. A copy of this reference is provided herewith.

Regarding claims 21 to 24, 26 and 27, the Office Action alleges that the phrase "and a 5% modulus value in the machine direction of [x] N/5 cm, but at least [y] N/gm<sup>2</sup>" is indefinite because it is unclear what "[y] N/gm<sup>2</sup>" refers to. Claims 21 to 24, 26 and 27 have been amended to recite Nm<sup>2</sup>/g, which are consistent with modulus units.

In light of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 11 to 29.

### **III. Rejection of Claims 11 to 29 Under 35 U.S.C. § 112, First Paragraph**

Claims 11 to 29 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Examiner stated that the Specification does not disclose how to make a tufted backing including the steps of (a) bonding fibers having a titer of 6-15 dtex by needling and (b) bonding fibers having a titer of 1-5 by hydroentangling or a combination of hydroentangling and needling.

Since the rejections under the first paragraph of 35 U.S.C. § 112 concern enablement, it is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent

coupled with information known in the art without undue experimentation.” (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See *id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See *id.*).

It is believed that the present assertions of the Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it plainly does. In short, it is believed that the Office Action’s arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, it is respectfully submitted that the subjective assertions of the Office Action are simply not supported by any real "evidence or sound scientific reasoning" -- which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (*See id.* ). Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." (*See id.* at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Office Action has not satisfied the foregoing for establishing that undue experimentation would be required. Indeed, the Office Action does not even allege that undue experimentation would be required to make and/or use the invention defined by the claims.

Notwithstanding the above, claim 11 has been amended to remove reference to a tufted backing and further clarifies the step of at least one of bonding fibers or filaments having a titer of 6 to 15 dtex in a portion of the spunbonded nonwoven by needling and bonding fibers or filaments having a titer of 1 to 5 dtex in another portion of the spunbonded nonwoven by using one of water jets and a combination of water jets and needling. Applicants respectfully submit that one

skilled in the art would not have to unduly experiment to practice the present invention, as recited in amended claim 11.

In light of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 11 to 29.

**IV. New Claims 30 to 33**

New claims 30 to 33 have been added herein. It is respectfully submitted that new claims 30 to 33 do not add any new matter and are fully supported by the present application, including the Specification. Because claims 30 to 33 contain features analogous to claim 11 it is respectfully submitted that claims 30 to 33 are allowable for at least the same reasons submitted above in support of the patentability of claim 11.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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